

## REMARKS

By this amendment, the specification has been amended. Claims 1, 4, 6, 10, 11, 14 and 17 have also been amended. Claims 1-21 remain in the application. Support for the amendments can be found the specification and drawings (as shown in FIGs. 1-2) as originally filed. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is respectfully requested.

### **Rejection under 35 U.S.C. §101**

Claims 17-21 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. By this response, claim 17 has been amended, and as presented, is directed to a method of generating a playlist in an *entertainment system*, the method comprising accessing and searching *via a first selector device* and searching *via a second selector device* to provide the playlist adapted to be used by a *rendering device*. Claim 17 now clearly recites those physical objects used to constitute the method. Accordingly, the rejection is now believed overcome. Claims 18-21 which depend from claim 17 are also believed to now overcome the rejection. Withdrawal of the rejection is respectfully requested.

### **Objection under 35 U.S.C. §132**

The amendment filed January 21, 2009 was objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. The objection is traversed for at least the following reasons.

With respect to the January 21, 2009 amendment to the specification for the paragraph beginning on page 3, line 27 through page 4, line 2, the applicant submits that "databases " are disclosed in the specification and drawings as originally filed. In particular, FIG. 1 illustrates three sources 110. As illustrated, the symbol used to represent each source 110 in FIG. 1 is a basic network shape for a database, data

source, or other data storage device, as is well known in the art. (See for example, database 115 of FIGs. 1 and 2 of cited art reference US 2002/0072982 A1 to Barton et al.) In addition, the specification of the present application, on page 4, line 1 and line 4, recites “sources 110 of content material.” Furthermore, the specification on page 6, lines 9-10 recites “content material in the sources 110.” Thus, it is submitted that the application (specification and drawings) as originally filed provides support for “databases” which refer to sources 110 in FIGs. 1 and 2. Accordingly, the objection is believed overcome. Withdrawal of the objection is requested.

With respect to the phrase “a periodic basis,” the specification has been amended herein to cancel the recitation of “(i.e., a periodic basis)” from the paragraph on page 7, lines 22-31. Accordingly, the objection is believed overcome. Withdrawal of the objection is requested.

The disclosure was objected to because of informalities in connection with the amendment filed January 21, 2009 concerning the new amended paragraph beginning on page 3, line 27 through page 4, line 2 in that the phrase “... (i.e.a device for playing a song identified in the playlist) ... was not clear. The objection is traversed for at least the following reasons. As presented herein, the paragraph on beginning on page 3, line 27 through page 4, line 2 has been amended to clarify the subject phase to now read “... (e.g., a rendering device 190 for playing a song identified in the playlist) ... .” Accordingly, the objection to the disclosure is now believed overcome. Withdrawal of the objection is requested.

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. In claims 1-10, the term “apparatus” had not been defined in the specification. The objection to the specification is traversed for at least the following reasons. As presented herein, the paragraph on beginning on page 3, line 27 through page 4, line 2 has been amended in the first sentence thereof to read “The

playlist generator 100 (i.e., apparatus 100) of FIG. 1 includes at least two selectors, 130, 150 (i.e., selector devices 130 and 150), that are configured to select material (via Net 120, for example, an Internet) from one or more sources 110 (e.g., databases of content material) to form a playlist 160 via a sequential filtering process.” Accordingly, the term “apparatus” is to be interpreted as “hardware” in the context of playlist generator 100 as shown in FIG. 1. The objection to the specification is now believed overcome. Withdrawal of the objection is respectfully requested.

### **Objection to the Claims**

Claims 1, 11 and 17 stand objected to because of informalities. The objection is traversed for at least the following reasons. By this amendment, claims 1, 11 and 17 have been amended to use the same terminology in both the specification and claims. That is, the specification and claims now use the terminology “highest hierarchical level” and “lower hierarchical level.” (Claims 6 and 10 were also amended to recite “lower hierarchical level.”) The objection to the claims is now believed overcome. Withdrawal of the objection is requested.

Claims 1, 6, 11 and 17 stand objected to because of informalities. In this objection, Applicant believes that the Examiner is referring to claim 10 rather than claim 11. The objection is traversed for at least the following reasons. By this amendment, claims 1, 6, 10 and 17 have been amended to change the phrase “is adapted for” to “is adapted to be used by a rendering device” in the respective claims. The objection to the claims is now believed overcome. Withdrawal of the objection is requested.

Claims 1-10 stand objected to because of the following informality: “apparatus” has not been defined in the specification. The objection is traversed for at least the following reasons. By this amendment, the specification has been amended as discussed herein above to include the term “apparatus” where appropriate, further as

discussed herein above. Accordingly, the objection to the claims is now believed overcome. Withdrawal of the objection is requested.

Claim 4 stands objected to because of informalities. The objection is traversed for at least the following reasons. By this amendment, claim 4 has been amended to recite "... user preferences include constant preferences ..." and thus clarify the claim. The objection to the claim is now believed overcome. Withdrawal of the objection is requested.

#### **Rejection under 35 U.S.C. §112**

Claims 1-21 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed for at least the following reasons.

With respect to claims 1, 11 and 17, the same had been amended for overcoming the prior rejection under 35 U.S.C. §101. The added limitations that were included in the corresponding claims are supported by the specification and drawings, as originally filed, further as discussed herein above with respect to overcoming the objections to the specification on page 3, line 27 through page 4, line 2. It is submitted that the specification and drawings, as originally submitted, support the limitation "at least one database source of material" (i.e., sources 110 in FIGs. 1 and 2) and the limitations "a first selector device" and "a second selector device" (i.e., selectors 130, 150 corresponding to first and second selector devices, or stated another way, selector 130 corresponds to the first selector device and selector 150 corresponds to the second selector device). Accordingly, the rejection is believed overcome. Withdrawal of the rejection is respectfully requested.

With respect to claims 1, 11 and 17, the same have also been amended to cancel the recitation of "periodic basis" and substitute therefore "weekly basis" as is

supported in the specification, as originally filed, on page 7, line 25. Accordingly, the rejection is believed overcome. Withdrawal of the rejection is respectfully requested.

With respect to claims 2-10, 12-16 and 18-21, the rejection is traversed for at least the following reason. The rejection of claim 1 has been overcome, thus claims 2-10 which depend from claim 1 are also believed to overcome the rejection. The rejection of claim 11 has been overcome, thus claims 12-16 which depend from claim 11 are also believed to overcome the rejection. The rejection of claim 17 has been overcome, thus claims 18-21 which depend from claim 17 are also believed to overcome the rejection. Withdrawal of the rejection is respectfully requested.

### **Rejection under 35 U.S.C. §103**

Claim 1 recites a playlist generator apparatus comprising:

a first selector device that is configured to access and search at least one database source of material and to provide therefrom a first subset of identifications of items within the at least one database source of material at a highest hierarchical level, based on a first set of parameters corresponding to a first set of user preferences, further wherein the first selector device is configured to access and search available database sources of material on a weekly basis to maintain the first subset of identifications of items up to date, and

a second selector device operatively coupled to the first selector device, wherein the second selector device is configured to search the first subset of identifications at a lower hierarchical level based on a second set of parameters corresponding to a second set of user preferences, and to provide therefrom a second subset of identifications of items within the database source of material, wherein the second subset corresponds to a playlist that is adapted to be used by a rendering device for a subsequent rendering of the items identified in the second subset.

Support for the amendments to claim 1 (as well as for claims 11 and 17) can be found in the specification at least on page 3, lines 7-13; page 7, lines 22-31; and FIGs. 1 and 2.

Claims 1-5, 11-13, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hoch (U.S. Pub. No. US 2003/0191753 AI), hereinafter **Hoch**, in view of Barton et al. (U.S. Pub. No. US 2002/0072982 AI), hereinafter **Barton**. With respect to claim 1, as presented herein, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

#### **1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The **Hoch** and **Barton** references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Hoch** nor **Barton** teaches a playlist generator apparatus comprising:

**(i) a first selector device ...**

**(i)(a)** to provide ... a *first subset* of identifications of items within the ... database source of material at a highest hierarchical level, based on a first set of parameters corresponding to a first set of user preferences, further ...

*(i)(b) configured to ... access and search available database sources of material on a weekly basis to maintain the first subset of identifications of items up to date,*

*and*

*(ii) a **second selector device** operatively coupled to the **first selector device** ...*

*(ii)(a) configured to ... search the first subset of identifications at a lower hierarchical level based on a second set of parameters corresponding to a second set of user preferences, and ...*

*(ii)(b) provide ... a second subset of identifications of items within the database source of material, wherein the second subset ... [is] a playlist ... adapted to be used by a rendering device for a subsequent rendering of the items identified in the second subset [emphasis added]*

as is now claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

In contrast, **Hoch** teaches filtering content with a multilevel hierarchical searching method based on a user's persona information using a learning mechanism. In particular, as illustrated in FIG. 6 thereof, the method of **Hoch** performs a search for content at one or more nodes of the community (step 602), filters the information received from the one or more nodes in response to the search (step 603), generates a search result (step 604), presents the search result (step 605), queries whether the user is satisfied (step 607), and if not satisfied, then receives a [user's] selection of at least a portion of the search result (step 606) and returns to step 602 wherein the method again searches the content at one or more nodes of the community (step 602) and thereafter repeats [emphasis added] (See Hoch at paragraph [0071] and [0074]-[0076]).

Accordingly, while **Hoch** discloses filtering using multiple levels of details and a learning algorithm based on a user's persona information, the method of **Hoch** teaches repeated searching the *nodes* of the *community* at the successive levels of the multilevel hierarchical searching. Accordingly, **Hoch** does not teach or suggest the limitations as

specifically recited in claim 1 of the present application.

In further contrast, **Barton** teaches a method for interacting with a user that employs a *captured sample* of an *experimental environment* in which the *user* exists as a *command* to *trigger* subsequent events (see Barton at paragraph [0006]). In paragraph [0013], **Barton** discloses that “a personal digital assistant or computer could be specially enabled to act as the *interactive service itself* by storing the database in its memory and performing the database query and processing without externally accessing the service.” **Barton** further discloses in paragraph [0013] that “transmission to the service provider would only be needed for additional interaction and potentially for *updates* of the *music database*, such as periodically (e.g., *weekly*).” In other words, the database (corresponding to the *service*) that would be stored on the personal digital assistant or computer is configured to operate without externally accessing the service (i.e., accessing the external database), except for additional interaction or updates to the database stored on the PDA or computer. Accordingly, **Barton** does not teach or suggest the limitations as specifically recited in claim 1 of the present application.

Thus, for this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## 2. The Combination of References is Improper

Assuming, arguendo, that the above argument for non-obviousness does not apply (which is clearly not the case based on the above), there is still another compelling reason why the **Hoch** and **Barton** references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.*



Here, neither **Hoch** nor **Barton** teaches, or even suggests, the desirability of the combination since neither teaches the specific playlist generator apparatus that includes **(i) a *first selector device* ... (i)(a) to provide ... a *first subset* of identifications of items within the ... *database source of material* at a highest hierarchical level, based on a *first set of parameters* corresponding to a first set of user preferences, further ... (i)(b) configured to ... access and search available database sources of material on a weekly basis to maintain the *first subset* of identifications of items up to date, and (ii) a **second selector device** operatively coupled to the **first selector device** ... (ii)(a) configured to ... search the *first subset* of identifications at a lower hierarchical level based on a *second set of parameters* corresponding to a second set of user preferences, and ... (ii)(b) provide ... a *second subset* of identifications of items within the *database source of material*, wherein the second subset ... [is] a *playlist* ... adapted to be used by a rendering device for a subsequent rendering of the items identified in the second subset [emphasis added]**" as specified above and as claimed in claim 1.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination as suggested by the office action arises solely from hindsight based on the invention without any showing,

suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claims 2-5 depend from and further limit independent claim 1 and therefore are allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Independent claim 11 has been amended herein to include limitations similar to those of claim 1. Accordingly, claim 11 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested. Claims 12 and 13 depend from and further limit independent claim 11 and therefore are allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Independent claim 17 has been amended herein to include limitations similar to those of claim 1. Accordingly, claim 17 is believed allowable for at least the same reasons as presented herein above with respect to overcoming the rejection of claim 1, and an early formal notice thereof is requested. Claim 18 depends from and further limits independent claim 17 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claims 6, 14 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton** as applied to claims 1, 11 and 17 above, in view of Salam et al. (U.S. Patent No. U.S. 6,594,654, hereinafter **Salam**). Applicant respectfully traverses this rejection for at least the following reason. Claim 6 depends from and further limits allowable independent claim 1 and therefore is allowable as well. Claim 14 depends from and further limits allowable independent claim 11 and therefore is allowable as well. Claim 21 depends from and further limits allowable independent claim 17 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claims 7-9, 15, 16, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton** as applied to claims 1, 11 and 17 above, in view of Breese et al. (U.S. Patent No. U.S. 6,006, 218, hereinafter **Breese**). Applicant respectfully traverses this rejection for at least the following reason. Claims 7-9 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Claims 15 and 16 depend from and further limit allowable independent claim 11 and therefore are allowable as well. Claims 19 and 20 depend from and further limit allowable independent claim 17 and therefore are allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Hoch**, in view of **Barton**, and further in view of **Breese**, as applied to claim 7 above, and further in view of **Salam**. Applicant respectfully traverses this rejection for at least the following reason. Claim 10 depends from and further limits allowable independent claim 1 and therefore is allowable as well. Accordingly, the 35 U.S.C. §103(a) rejection thereof has now been overcome. Withdrawal of the rejection is requested.

### **Conclusion**

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 11 and 17 are in condition for allowance. Dependent claims 2-10 depend from and further limit independent claim 1 and therefore are allowable as well. Dependent claims 12-16 depend from and further limit independent claim 11 and therefore are allowable as well. Dependent claims 18-21 depend from and further limit independent claim 17 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-21 is requested.

Respectfully submitted,

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